

REMARKS

Claims 1-4, 6 and 7 are all the claims pending in the application. By a concurrent filing of an RCE, Applicants have completed steps necessary to have entered the Amendment filed on January 15, 2009. Applicants also are submitting this amendment under 37 C.F.R. § 1.114(c) in order to add new claim 8, which is identical to claim 1, but does not have the express exclusion of tin.

Advisory Action

In the Advisory Action dated January 29, 2009, the Examiner states that

“Applicants proposed amendments to the claims are acknowledged but are deemed to raise issues of new matter not disclosed in the Specification as originally filed. Specifically, although Applicants Specification reasonably provides supporting basis for the recited limitation wherein the glass substrate contains lithium ions (see for example Spec page 6, 3), the Specification has been found to lack support for the limitation excluding tin from the substrate composition.”

No Disclosure of Tin

There can be no question that the disclosure of the present application includes a variety of glass compositions for a glass substrate for a magnetic disk, but that NONE of those compositions has tin. This alone is a basis for supporting the negative limitation “and not tin” in claim 1.

To the extent that the Examiner finds tin expressly or implicitly included in any of the disclosed glass compositions, or other disclosure in the original specification, he is requested to specifically identify that basis.

Case Law Permits Submitted Negative Limitation

The Examiner provides no basis for concluding that the negative limitation added to claim 1 is new matter or otherwise improper. Indeed, since the specification does not have any teaching of a glass composition that has tin, there is clear support for this negative limitation.

Applicants submit that the case law does permit the negative limitation to “no tin” on the basis of *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). There the Board held that a lack of literal basis in the specification for a negative limitation would not be

sufficient to establish a *prima facie* case for lack of descriptive support. Indeed, the Board found in a case where the claim stated that the process is “conducted in the absence of a catalyst” and the original specification merely disclosed processes where no catalyst was included (without expressly excluding catalysts), that the originally filed disclosure need only convey, to one of skill in the art, that applicant had possession of concept of what is claimed. The Board held that “it cannot be held that originally filed disclosure would not have conveyed concept of effecting decomposition at elevated temperature in absence of catalyst.”

Present Claim Limitation Is Within Case Law

In the present case, there is no disclosure of the use of tin in the glass used for a magnetic substrate. Moreover, those of ordinary skill would understand that tin would be found in other glass applications, particularly where sheet glass is made by a float process on liquid tin, as in the prior art. Thus, on the basis of the original disclosure, it would be conveyed to those of ordinary skill that, given the absence in the original specification of any mention of tin as a component of the glass for a substrate, the inventors had possession of the concept of manufacturing a glass substrate containing alkali ions and chemically strengthening the substrate with first and second alkali ions, where the glass substrate contains no tin.

Thus, consistent with the decision in *Ex parte Parks*, the exclusion of tin would not be new matter, was in the possession of the inventors, and would be consistent with the original concept of the invention as disclosed in the original specification.

Interview Requested

Applicants respectfully request an interview with the Examiner to discuss these issues, to the extent that the Examiner does not agree with the controlling case law and Applicants’ position as to existing support for the added limitation.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No.: 10/777,680

Attorney Docket No.: Q79867

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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